

REMARKS

This is intended as a full and complete response to the Office Action dated July 27, 2005, having a shortened statutory period for response set to expire on October 27, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-79 remain pending in the application and are shown above. Claims 14-31, 33, 34, 36, 37, 39, 40, 45, 46, 48, 49, 51-53, 57-63, 65, 66, 68, 69, 71, 72 and 76-79 stand withdrawn by the Examiner. Claims 1-13, 32, 35, 38, 41-44, 47, 50, 54-56, 64, 67, 70 and 73-75 stand rejected by the Examiner. Claims 1-13, 32 and 54 have been amended. Applicant submits that new matter is not introduced in the amendments. Reconsideration of the rejected claims is requested for reasons presented below.

Claim Rejections – 35 USC § 102

Claims 1-3, 5, 6, 11-13, 32, 35, 38, 44, 47, 50, 54-56 64 and 70 stand rejected under 35 U.S.C. 102(e) as being anticipated by the pre-grant publication '410 to *Underhill*.

Applicant respectfully traverses this rejection.

The Examiner asserts that *Underhill* discloses a tool having an expansion member (402) which is lockable in an extended configuration (dashed lines) by a locking assembly (444,472 and 478). Applicant respectfully submits that *Underhill* discloses using the pin (444) to hold the expansion member (402) in a retracted position (solid lines) when moving the tool to and from a working position (Figure 18, and paragraph 44). *Underhill* does not teach locking the expansion member in the extended configuration as claimed in the present invention. Furthermore, in Figure 18, *Underhill* does not teach or suggest using an activating member for moving the expansion member towards the extended configuration as claimed in the present invention. Additionally, expansion tools in Figure 13 and 17 of *Underhill* have expansion members (180 and 302) moved by activating members (158 and 372) propelled by fluid pressure in a fluid chamber (paragraphs 40 and 43). However, *Underhill* does not teach or suggest a locking assembly for locking the activating members as disclosed in the present invention.

Therefore, *Underhill* does not teach a tubing expansion tool comprising a body, at least one expansion member radially movably mounted on the body for movement towards an extended configuration describing an expansion diameter, an activating member movable within the body and having an activating position in which the activating member urges the expansion member towards the extended configuration, and a locking assembly for locking the activating member in the activating position to maintain the expansion member in the extended configuration, as recited in amended claim 1, and claims dependent thereon.

Regarding claim 54, *Underhill* does not teach locking the activating member using a locking assembly when the expansion member is in the extended configuration, as set forth in amended claim 54, and claims dependent thereon.

Therefore, claims 1-3, 5, 6, 11-13, 32, 35, 38, 44, 47, 50, 54-56 64 and 70 are believed to be in condition for allowance. Withdrawal of this rejection is respectfully requested.

Claims 1, 3, 6-8, 32, 35, 38, 41, 42, 44, 54-56, 64, 67 and 70 stand rejected under 35 U.S.C. 102(a) as being anticipated by the WIPO document '456 to *Oosterling et al.* (hereafter *Oosterling*).

Applicant respectfully traverses this rejection.

Oosterling discloses an expansion device having expansion members, i.e. radially movable fingers (22). The movable fingers (22) are biased outwards by an activating member, i.e. a shaft (16) coupled to a spring (18). During expansion of an expandable member, if the expansion device encounters a restriction, the spring (18) extends and the shaft (16) moves upwards so that the movable fingers 22 can move inwards to a retracted position to allow the expansion device to pass through (Abstract, Figure 1). However, *Oosterling* does not teach a locking assembly configured to lock an activating member when the expansion member is in an extended configuration as disclosed in the present invention.

Additionally, the objective of *Oosterling* is to pass through restrictions by retracting expansion members which are normally extended. Thus *Oosterling* does not

want the expansion members locked in a configuration. Therefore, *Oosterling* teaches away from locking the expansion member in the extended configuration.

Thus, *Oosterling* does not teach a tubing expansion tool comprising a body, at least one expansion member radially movably mounted on the body for movement towards an extended configuration describing an expansion diameter, an activating member movable within the body and having an activating position in which the activating member urges the expansion member towards the extended configuration, and a locking assembly for locking the activating member in the activating position to maintain the expansion member in the extended configuration, as recited in amended claim 1, and claims dependent thereon.

Similarly, *Oosterling* does not teach locking the activating member by a locking assembly when the expansion member is in the extended configuration as set forth in amended claim 54, and claims dependent thereon.

Therefore, claims 1, 3, 6-8, 32, 35, 38, 41, 42, 44, 54-56, 64, 67 and 70 are believed to be in condition for allowance. Withdrawal of this rejection is respectfully requested.

Claim Rejections – 35 USC § 103

Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Underhill*.

Applicant respectfully traverses this rejection.

As discussed above, *Underhill* discloses an expansion device which can be locked in a retract configuration before and after an expansion process. *Underhill* does not teach, show or suggest a tubing expansion tool having at least one expansion member lockable in an extended configuration by a locking assembly, as set forth in claim 1, on which claim 4 is dependent on. Therefore, claim 4 is believed to be in condition for allowance. Withdrawal of this rejection is respectfully requested.

Claims 9 and 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Oosterling* in view of US Patent 3,545,543 to *Kammerer, Jr.* (hereafter *Kammerer*).

Applicant respectfully traverses this rejection.

As discussed above, *Oosterling* teaches away from locking an extendable member from an extended configuration. *Kammerer* teaches a well-casing shoe having holding members/anchor dogs 37 which may be held in an opened position by a piston 46 connected to a latch ring 48. However, *Kammerer* does not teach a tubing expansion tool set forth in claim 1. Therefore, *Oosterling* and *Kammerer*, alone or in combination, do not teach, show or suggest the tubing expansion tool set forth in claim 1, on which claims 9 and 10 are dependent. Claims 9 and 10 are believed to be in condition for allowance. Withdrawal of this rejection is respectfully requested.

Claim 43 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Oosterling* in view of *Underhill*.

Applicant respectfully traverses this rejection.

As discussed above, *Oosterling* teaches away from locking an extendable member from an extended configuration. *Underhill* does not teach, show or suggest a tubing expansion tool having at least one expansion member lockable in an extended configuration by a locking assembly, as set forth in claim 1, on which claim 4 is dependent on. The combination of *Underhill* and *Oosterling* does not teach, show or suggest claimed subject matter set forth in claim 1, on which claim 43 is dependent. Therefore, claim 43 is believed to be in condition for allowance. Withdrawal of this rejection is respectfully requested.

Claims 73-75 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Underhill* or *Oosterling* in view of the WIPO document '766 to *Simpson et al.* (hereafter *Simpson*).

Applicant respectfully traverses this rejection.

Underhill and *Oosterling* are discussed above. *Simpson* discloses methods and apparatus for shaping pipes, tubes, liners or casing at downhole locations. However, *Simpson* does not teach locking an activating member for moving an expansion member when the expansion member is an extended configuration, as set forth in claim 54. Thus, the combination of *Underhill* and *Simpson*, or *Oosterling* and *Simpson*, does not teach, show or suggest the method set forth in claim 54, on which claim 73-75 are

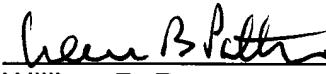
dependent. Therefore, claims 73-75 are believed to be in condition for allowance. Withdrawal of this rejection is respectfully requested.

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicant's disclosure than the primary references cited in the office action. Therefore, Applicant believes that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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